UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,864	07/28/2006	Didier Colavizza	Q95819	9777

23373 7590 09/17/2010
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
BADR, HAMID R	

ART UNIT	PAPER NUMBER
1781	

NOTIFICATION DATE	DELIVERY MODE
09/17/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Advisory Action

Applicants' amendment/remark after final rejection filed 8/16/2010 is acknowledged.

The rejection of claims 17-19 under 35 U.S.C. 102(b) is withdrawn per Applicants persuasive remarks.

The rejection of claims 17-41 under 35 U.S.C. 103(a) over Satoshi et al. in view of Hill is maintained. However, the remarks, concerning the rejection under 35 U.S.C. 103(a), will be entered for appeal purposes.

The arguments as presented by Applicants, regarding the rejection of claims 17-41 under 35 USC 103(a), are not persuasive for the following reasons.

Response to Arguments

1. Applicants argue that the method of Satoshi et al. is different from the method used in the present application.

a. Applicants should realize that even if a product by process is limited by the process (method), the patentability is determined by the product itself.

R1 discloses baker's yeast strains which are highly sugar and freeze tolerant, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further,

"although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Satoshi et al. meets the requirements of the claimed sugar and freeze tolerance by baker's yeast, Satoshi et al. clearly meet the requirements of the present claims.

Despite the fact that applicants have provided specific deposit names for the isolated strains disclosed and claimed, this does not provide a patentable distinction over those strains disclosed by Satoshi et al. as also having high sugar and freeze tolerance, absent any clear and convincing evidence and/or arguments to the contrary. The USPTO does not possess the facilities to test each strain of microorganism. However, a reasonable rejection has been set forth and thus the burden shifts to applicant to demonstrate that the strain of Satoshi et al. is not, in fact, as high sugar and freeze tolerant as that of the claimed strain. Alternatively, given the specific teachings of Satoshi et al. ; one would have been motivated to routinely develop and screen out the identified strains and utilize such strains within the known methods of Satoshi et al.

2. Applicants argue that Satoshi et al. do not meat the requirements of present claims 17-22.

a. Satochi et al. is being cited in an obviousness rejection. Given the specific

teachings of Satoshi et al. ; one would have been motivated to routinely develop and screen out the identified strains, using Satoshi methods or any known methods in the art; expecting to isolate sugar and freeze tolerant strains and utilize such strains within the known methods of Satoshi et al.

3. Applicants argue that in Satoshi et al., the genetic material of the obtained strains is substantially the same as that of the parent strain, whereas the strains obtained according to the present invention have a different genetic material.

a. Satoshi is teaching the concept of high sugar and freeze tolerance in baker's yeast using hybridization methods. The strains of Satoshi et al. are highly sugar and freeze tolerant. The sugar and freeze tolerance determine the patentability not the method by which the yeast strains were developed.

The motivation would have been set forth by Satoshi et al. to develop sugar and freeze tolerant using hybridization methods known in the art and expecting to isolate sugar and freeze tolerant strains of baker's yeast.

4. Applicants argue that it cannot be reasonably expected that the variants of TYR strains obtained in Satoshi et al. are the same as the claimed strains.

a. The question is not whether the strains as disclosed by Satoshi et al. are the same as the strains as presently claimed. The fact is that the presently claimed strains would be obvious in view of the teachings of Satoshi et al.

5. Applicants argue that Hill teaches how to propagate yeast in the presence of organic acids but does not disclose any methods of producing new yeast strains.

a. Hill is a secondary reference which teaches of how to adapt any strain of yeast to

the presence of weak organic acids as presently claimed in claim 23. Therefore, strains would have been developed adopting the teachings of Satoshi, or other known methods in the art, and the developed strains would have been adapted to the presence of weak organic acids as taught by Hill and as presently claimed.

6. Applicants argue that the Examiner's argument that Satoshi's strains are more efficient is not substantiated because no reasonable technical basis has been provided.

a. Applicants admit the fact that the Examiner stated very clearly that the doughs and the baking conditions and materials of Satoshi et al. and the presently claimed doughs and materials are not the same, therefore, a direct comparison is not possible. However, for the sake of comparison, the sugar to yeast ratio in Satoshi was compared to the sugar to yeast ratio as presently disclosed. It was concluded that because of a higher sugar to yeast ratio in Satoshi, the strains of Satoshi are more efficient. Furthermore, claim 33 requires that the dough contain 15% sugar relative to the mass of flour. Satoshi discloses in a single example that the dough contains 16.5% sugar relative to the mass of the flour. Regarding this comparison, the strain of Satoshi et al. meet the requirement for sugar concentration as well.

7. Applicants argue that as rightly noted by the Examiner, the controls and criteria for assessment are not the same in Satoshi and as presently disclosed, therefore a comparison is not to be made.

a. Since the Applicants compared tow experiments for which controls and criteria are not the same, namely Satoshi's example and Applicants' example, a conclusion, regarding the superiority of the hybrids developed by Applicants, based only on the

sugar concentration in the Applicants example can not be made.

8. Applicants argue that a significant improvement of as high as 25-35% in terms of proof time is obtained with the claimed strains.

a. The developed strains, by Applicants, are supposedly more efficient compared with the reference strains they used. The developed strains (hybrids) are expected to be improved strains regarding certain traits when they are compared with their parent strains. The 25-35% improvement in proof time has been achieved by Applicants when their hybrids are compared with the regular yeasts they have used as parent strain or simply compared with a regular reference yeast they have used. However, this does not mean that their developed hybrids are 25-35% improved over the strains of Satoshi. No claims are allowable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAMID R. BADR whose telephone number is (571)270-3455. The examiner can normally be reached on M-F, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hamid R Badr
Examiner
Art Unit 1781

/Keith D. Hendricks/
Supervisory Patent Examiner, Art Unit 1781